

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Daniel J. KESSLER

Group Art Unit: 2837

Application No.: 10/626,563

Examiner: K. Lockett

Filed: July 25, 2003

Docket No.: 109889

For: MUSIC INSTRUMENT COVER

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal and a Petition for Extension of Time are filed herewith.

Applicant respectfully requests review of the Final Rejection mailed April 28, 2005 in the above-identified application.

The Advisory Action mailed on June 21 indicates that Applicant's amendments filed on June 10 will be entered for purposes of appeal. Therefore, the claims on appeal are as shown in the June 10 Amendment After Final Rejection. Claims 1-5, 7 and 8 are allowed, and claims 10-13, 15, 16 and 18 are rejected. Claim 19 was canceled by the Amendment.

This review is requested for the following reasons.

**I. The Rejection of Claim 19 (Now Claim 10)
Over Hearfield In View of Britto Is In Error**

Regarding claim 19 (now claim 10), the Office Action and Advisory Action assert that it would have obvious to combine the teachings of the references in a manner that resulted in the claimed invention. However, for any of the following reasons, a proper motivation for combining the references has not been established. (These reasons were presented in

Applicant's June 10 Amendment After Final Rejection and July 27 Request for Reconsideration After Advisory Action, but were not responded to by the Patent Office.)

First, Hearfield specifically touts leather as the "ideal material" for its disclosed guitar cover, distinguishing it as providing better protection than "thin plastics, cotton or other textile materials" (see col. 3, lines 28-55). (See also col. 3, lines 60-62, which state, "all the embodiments have the following characteristics in common: the covers are of leather.") Therefore, Hearfield teaches away from materials that are not leather. In view of this teaching away, one of ordinary skill in the art would not have been motivated to make the change proposed by the Office Action, despite the disclosure of another material by Britto (or any other reference.)

Second, Hearfield's device already accomplishes the purpose of "tightly covering a musical instrument." Therefore, the alleged motivation for the combination is without merit.

Third, Britto is not analogous to Hearfield. Britto discloses a box, which may be a music box, but those skilled in the art of guitar covers would not have found it obvious to employ teachings related to a music box to a guitar cover.

Fourth, the principle of attachment of Britto's cover would not work with a guitar, for the following reasons. As discussed at column 4, lines 18-26, with reference to Fig. 6, Britto describes that the cover is stretched tight across the face of a base 12 by a tie 74. As explained in column 4, line 26, the tie 74 is made snug about the base of a tube portion that extends within the base 12. This mechanism of making the cover tight may work with a box, as in Britto, because there are no concave portions on the surface that is being covered. In contrast, with a guitar, as in Hearfield, the surface to be covered has concave portions. The cover of Britto would not be tight against the concave portions of the guitar body when made snug according to the teachings of Britto.

Accordingly, one of ordinary skill in the art would not have found it obvious to employ the teachings of Britto in the Hearfield device. The Office Action's conclusion to the contrary ignores these points, and is in violation of MPEP §2141.02 (see, e.g., the part entitled "PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS," and the part entitled "FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS).

II. The Rejection of Claim 18 Over Messina In View of Britto Is In Error

Regarding claim 18, the Office Action and Advisory Action assert that it would have obvious to combine the teachings of the references in a manner that resulted in the claimed invention. However, for any of the following reasons, a proper motivation for combining the references has not been established. (These reasons were presented in Applicant's June 10 Amendment After Final Rejection and July 27 Request for Reconsideration After Advisory Action, but were not responded to by the Patent Office.)

First, there is no evidence that the Messina device does not already "tightly cover" the guitar body. Therefore, the alleged motivation for the combination is without merit.

Second, Messina discloses a guitar cover, while Britto discloses a box cover. Because the device, context and teachings of Britto are not analogous to those of Messina, one of ordinary skill in the art would not have been motivated to use the music box-related teachings of Britto with a guitar cover.

Third, the principle of attachment of Britto's cover would not work with a guitar, as explained in connection with claim 10 and the Hearfield reference.

Accordingly, one of ordinary skill in the art would not have found it obvious to employ the teachings of Britto in the Messina device. The Office Action's conclusion to the

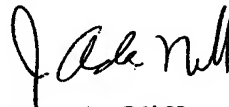
contrary ignores these points, and is in violation of MPEP §2141.02 (see, e.g., the part entitled "PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS," and the part entitled "FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS).

III. Conclusion

In view of the foregoing, Applicant maintains that all of the pending claims are patentable over the applied prior art, and requests withdrawal of the rejections and allowance of the application.

Should the review panel believe that anything further is desirable to place the application in even better condition for allowance, it is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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Attachment:
Notice of Appeal

Date: August 29, 2005

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